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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,010	10/25/2001	Jonathan W. Nyce	EPI-00312	5176
27194	7590	10/16/2003	EXAMINER	
HOWREY SIMON ARNOLD & WHITE, LLP			JIANG, SHAOJIA A	
BOX 34				
301 RAVENSWOOD AVE.			ART UNIT	
MENLO PARK, CA 94025			PAPER NUMBER	
			1617	

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/072,010

Applicant(s)

NYCE, JONATHAN W.

Examiner

Shaojia A Jiang

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY (check either a) or b))

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 708.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 September 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 80-127 and 159.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
10. ☐ Other: _____


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

10/14/03

Advisory Action

This Office Action is a response to Applicant's proposed amendment and response after FINAL filed on September 23, 2003.

2. Applicant's proposed amended claims, present a new issue for search and consideration by the Examiner. Moreover, Applicant's proposed amended claims are not deemed to place the application in better form for appeals by materially reducing or simplifying the issues for appeal.

5. Applicant's remarks filed September 23, 2003 with respect to the rejection of claims 80-85, 94-100, 103-106 and 108 made under 35 U.S.C. 102(b) as being anticipated by Langsjoen et al. (5,011,858 of record); the rejection of claims 80-85, 94-103, 107-108, and 113 made under 35 U.S.C. 102(b) as being anticipated by Brasey et al. (4,778,798 of record); the rejection of claims 80-85, 94-99, and 111 made under 35 U.S.C. 102(b) as being anticipated by Bertelli, Alberto (4,654,373 of record); and the rejection of claims 109-110, 112, and 114-127 made under 35 U.S.C. 103(a) as being unpatentable over Langsjoen et al. (5,011,858), Brasey et al. (4,778,798), and Bertelli in view of Lieberman et al. (Pharmaceutical Dosage Forms, page 110); the rejection of claims 80, 86-93 and 159 made under 35 U.S.C. 102(b) as being anticipated by Nyce (5,527,789, of record); the rejection of claims 80, 86-93, and 159 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-19 of U.S. Patent No. 5,527,789 (of record) have been fully considered but

are unpersuasive for reasons of record stated in the Final Office Action dated April 23, 2003.

As discussed in the Final Rejection, in view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

S. A. Jiang, Ph.D.
Patent Examiner, AU 1617
October 14, 2003